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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,564	01/03/2001	Hirofumi Sakaue	32405W061	9797

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EXAMINER

STRIMBU, GREGORY J

ART UNIT PAPER NUMBER

3634

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,564

Applicant(s)

SAKAUE ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004 and 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

Claims 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper No. 10.

Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the previous examiner examined all of the claims. This is not found persuasive because there is no evidence of record that the examiner did in fact examine claims 14-16. First, claims 14-16 were presented after the first office action of December 28, 2001 and no subsequent office action was issued by the previous examiner. Additionally, there is no record of the conversation of May 2, 2002 was indeed an interview discussing the merits of the application. Neither the examiner nor the applicant has presented an interview summary stating what transpired during the conversation of May 2, 2002. It is unclear to the examiner why the applicant has not submitted an interview summary detailing what was discussed and agreed to if the conversation of May 2, 2002 was in fact an interview. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

Claims 6, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "an opening direction" on line 3 of claim 6 render the claims indefinite because it is unclear if the applicant is referring to the opening direction set forth above or is attempting to set forth another direction in addition to the one set forth above. Also see "closing direction" on line 5 of claim 7 and "an opening and closing motion" on line 2 of claim 11. Recitations such as "closing speed" on line 3 of claim 7 render the claims indefinite because it is unclear what element the applicant is referring to. In other words, it is unclear what element of the invention has the closing speed to which the applicant refers. Recitations such as "when said rear gate performing" on line 3 of claim 8 are grammatically awkward and confusing. Also see lines 2-3 of claim 17.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Publication No. 41 24 869. German Patent Publication No. 41 24 869 discloses an apparatus comprising a power source unit 9 that produces power, a slider 12 that transforms the power into a reciprocating motion, a hinge arm 3, a connecting rod 20 that interlocks the slider and the hinge arm, the rod transmitting the reciprocating motion to the hinge arm, a mounting base 6 that supports the power source unit and the slider, a mounting base installer 22, and a gas stay 5 attached to the hinge arm at one

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end, disposed at substantially the same height as and approximately in parallel with the connecting rod and extending in the longitudinal direction of the vehicle for biasing the rear gate in an opening direction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 8, 9, 11, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 as applied to claims 1 and 2 above, and further in view of Hellinga et al. Hellinga et al. discloses a clutch 5, a position detector (not numbered, but see column 6, lines 15-22), a manipulator 8, a controller 7, a handle switch 24

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869 with a clutch, a position detector, a manipulator, a controller, as taught by Hellinga et al., to enable a user to manually operate the closure and to accurately and safely move the closure

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 in view of Hellinga et al. as applied to claims 3, 4, 8, 9, 11, 12, 13 and 17 above, and further in view of Kato. Kato discloses an

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apparatus having a controller 2 that controls an opening and closing speed of the closure D.

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869 with a speed controller, as taught by Kato, to ensure the smooth movement of the closure between the open and closed positions.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 in view of Hellinga et al. as applied to claims 3, 4, 8, 9, 11, 12, 13 and 17 above, and further in view of Kowall et al. Kowall et al. discloses an rear lift gate apparatus having an alarm 52.

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869, as modified above, with an alarm, as taught by Kowall et al., to enable a user to know an object is obstructing the movement of the closure.

Response to Arguments

Applicant's arguments filed January 9, 2004 have been fully considered but they are not persuasive.

The applicant's comments concerning German Patent Publication No. 41 24 869 are not persuasive because they are not supported by the claim language. Note that the applicant has set forth the subcombination of an apparatus and not the combination of an apparatus and a rear gate of a vehicle. Therefore, the apparatus of German

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Patent Publication No. 41 24 869 only need be capable of performing as the applicant recites in the claims in order to anticipate the claims. It is the examiner's position that the apparatus of German Patent Publication No. 41 24 869 is clearly capable of performing as intended by the applicant. The slider 12 is not only capable of, but actually moves in a longitudinal direction of the vehicle since it includes both a vertical component and a horizontal component as shown in the figure. The mounting base installer 22 is capable of being detachably installed the mounting base 6 in a space formed by a rear rail, a side rail and under a roof of the vehicle. Finally, German Patent Publication No. 41 24 869 discloses a gas stay 5 which extends in the longitudinal direction and is capable of rotatably attaching to a side rail at one end thereof.

If the applicant were to positively recite the combination of the apparatus and the vehicle, the application may be allowable.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
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March 5, 2004